IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Thomas Odorzynski Art Unit: 3688
Serial No. 10/748,715
Filed December 30, 2003
Confirmation No.: 2119
For: SELLING AD SPACE ON DIAPERS
Examiner Saba Dagnew

January 13, 2010

REPLY BRIEF

Applicants are submitting this Reply Brief in response to Examiner's Answer dated December 9, 2009.

The Office maintains on page 7 of the Examiner's Answer that given the broadest reasonable interpretation of both the terms underwear and diaper, and given that a diaper is typically worn next to the skin under outer clothes and usually only seen in private, one of ordinary skill in the art would consider a diaper as underwear. Applicants respectfully disagree. Initially, Applicants submit that the Office appears to have overlooked the fact that Applicants' claimed invention is not directed to the use of all diapers in general, but rather, is more specifically directed to the use of disposable diapers in particular. Applicants submit that one skilled in the art would understand that such disposable diapers have a completely different structure than other types of diapers, such as cloth diapers. As such, even if one skilled in the art could conclude that certain types of diapers (i.e., cloth diapers) could be considered similar to that of the underwear disclosed by the Gabler reference, it would not be reasonable to conclude that a disposable diaper, as is required in Applicants' claimed

invention, is the equivalent to the underwear disclosed by the Gabler reference.

Furthermore, even if one skilled in the art concluded that a disclosure of underwear implicitly includes a disclosure of diapers (which Applicants maintain is not the case), there is still no disclosure in Gabler of any specific type of diaper, much less a disposable diaper, as is required by Applicants' claimed invention. More specifically, the Office asserts that through Gabler's disclosure of underwear, Gabler implicitly discloses diapers. Applicants' claimed invention, however, includes the recitation of disposable diapers, which is a species of the genus of diapers in general. As stated in M.P.E.P §2131.02, a genus does not read on a claim to a species within a genus, unless the species is clearly named or well delineated. Applicants assert that the broad generic disclosure of underwear in the cited reference, and thus, as asserted by the Office, an implicit broad disclosure of diapers in general, fails to clearly provide or delineate the **disposable** diapers. As such, for at least this reason, Applicants submit that the claimed invention is patentable over the cited references.

Further, the Office asserts at page 7 of the Examiner's Answer that claim 33 is not rendered patentable over the cited references merely because of the inclusion of the structure of the disposable diaper as the structure of a diaper is "old and well known in the art." Although Applicants agree with the Office that the general structure of a disposable diaper is known in the art, Applicants submit that the Office has misinterpreted the point of Applicants' argument. Specifically, Applicants have not argued that it is the structure itself of the disposable diaper recited in claim 33 that renders the claim patentable, but rather, it is the method including the steps of

selling space on a disposable diaper to a sponsor and placing an ad for a product other than disposable diapers onto the disposable diaper that renders the claimed invention patentable over the cited references. As this method is not described by the cited references, Applicants submit that claim 33 is patentable over the cited references.

In addition, the Office maintains of page 8 of the Examiner's Answer that the structure of the diaper as recited in claim 33 does not impact the manipulative steps of the method and is therefore given little patentable weight. Further, in response to Applicants' argument that this limitation (the structure of the disposable diaper) should be given patentable weight as the means for attaching an advertisement to an article will change depending on the article to which it is attached, the Office further asserts that by making such an argument, the appellant is arguing limitations not currently recited in the claims. Applicants assert that the Office has again misinterpreted Applicants' argument. In explaining that the means for attaching an advertisement to an article will change depending on the article to which the advertisement is to be attached, Applicants' have not asserted that it is the method by which the advertisement is attached to a disposable diaper that renders the claim patentable over the cited reference. Rather, this information was provided to the Office to illustrate the importance of reading each and every word of the claim, and further, of rightfully affording patentable weight to the specific words "disposable diaper."

Conclusion

In addition to the reasons set forth in Applicants' Appeal Brief, the rejections of the claims on appeal are in error for the reasons set forth above. Therefore, Applicants request that the Examiner's rejections of claims 1, 3-8, 10-18, 20, 22, 24-29, and 31-33 be reversed. Applicants do not believe that any fee is due in connection with this reply. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment of any fees during the pendency of this application to Deposit Account No. 01-2384.

Respectfully submitted,

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